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07 AUG 2007

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CHERSKOV & FLAYNIK
THE CIVIC OPERA BUILDING
20 NORTH WACKER DRIVE, SUITE 1447
CHICAGO IL 60606

In re Application of : DECISION ON
Howitt :
Application No.: 10/590,616 :
Int. App. No.: PCT/GB05/00142 : PETITION UNDER
Int. Filing Date: 17 January 2005 :
Priority Date: 24 February 2004 : 37 CFR 1.137(a)
Docket No.: 0078-01889 : &
For: Emergency Evacuation Apparatus : 37 CFR 1.137(b)
For A Bed-Ridden Person :
:

This is in response to the petition to revive filed on 08 May 2007.

BACKGROUND

This international application was filed on 17 January 2005, claimed an earlier priority date of 24 February 2004, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 09 September 2005. The 30 month time period for paying the basic national fee in the United States expired at midnight on 24 August 2006. This international application became abandoned with respect to the national stage for failure to timely pay the basic national fee, pursuant to 35 U.S.C. 371(d), as of midnight on 24 August 2006.

DISCUSSION

Petition Under 37 CFR 1.137(a)

Petitioner argues that the delay in filing the basic national fee in this application was unavoidable. 37 CFR 1.137(a) provides that

If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;

- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

Regarding requirement (1), petitioner filed the basic national fee on 08 May 2007.

Regarding requirement (2), petitioner filed the petition fee on 08 May 2007.

Regarding requirement (3), petitioner argues in part that

Failure to pay resulted from the non-receipt of a notice to file missing parts. The attorney of record, on August 24, 2006 timely filed an application to initiate national proceedings pursuant to 35 U.S.C. 371. The application contained all required elements, except for a signed declaration and a fee check. Consequently, the attorney of record expected to receive a notice of missing parts which would allow the applicant to submit both documents. However, according to Private PAIR, no notice to file missing parts had been sent from the USPTO.

Concerned about the status of the application, the attorney of record sent a Status Inquiry on January 19, 2007 (confirmation enclosed). Rather than receiving a response to the Status Inquiry, the attorney of record received the Notice of Abandonment. Up to this time, it was impossible to verify the status of the application as access to it via Private PAIR had not been granted even though the original documents correctly identified the office of the attorney of record who has a Private PAIR account. Had the Patent Office sent a Notice of Missing Parts or had counsel been granted Private PAIR access, the abandonment would have been avoided.

Petitioner's attention is drawn to 35 U.S.C. 371(d), which provides that

The requirement with respect to the national fee referred to in subsection (c)(1), the translation referred to in subsection (c)(2), and the oath or declaration referred to in subsection (c)(4) of this section shall be complied with by the date of the commencement of the national stage or by such later time as may be fixed by the Director. The copy of the international application referred to in subsection (c)(2) shall be submitted by the date of the commencement of the national stage. Failure

to comply with these requirements shall be regarded as abandonment of the application by the parties thereof, unless it be shown to the satisfaction of the Director that such failure to comply was unavoidable.

Attention is also drawn to 37 CFR 1.495(b)(2), which states that

(b) To avoid abandonment of the application, the applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of thirty months from the priority date:

(2) The basic national fee (see § 1.492(a)).

The basic national fee was due no later than midnight on 24 August 2006. This time period was not subject to extension, nor was the abandonment of the application caused by the mailing or non-mailing of a Notification of Missing Requirements. Instead, the abandonment of this application could have been avoided through the exercise of ordinary diligence. For instance, in view of 35 U.S.C. 371(d) and 37 CFR 1.495(b)(2), petitioner could have included the basic national fee along with the correspondence filed on 24 August 2006. As petitioner has not shown why failure to do so was unavoidable within the meaning of 37 CFR 1.137(a), it would not be appropriate to grant the requested relief at this time.

With regard to requirement (4), no terminal disclaimer is required.

Petition Under 37 CFR 1.137(b)

In the alternative, petitioner requests relief under 37 CFR 1.137(b). A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Regarding requirement (1), the “required reply” in the form of the basic national fee has been paid.

Regarding requirement (2), the petition includes authorization to charge the \$750.00 petition fee to counsel’s Deposit Account No. 50-1709.

Regarding requirement (3), the petition includes a statement that “the abandonment was

unintentional.” This is being construed as a statement that “the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.” Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement is not correct. Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

Regarding requirement (4), no terminal disclaimer is required.

DECISION

The petition under 37 CFR 1.137(a) is **DISMISSED**, without prejudice.

The petition under 37 CFR 1.137(b) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **08 May 2007** (i.e., the date the basic national fee was paid).



George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459